

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No: 6,136,063)	
)	
Issue Date: October 24, 2000)	
)	
Application Serial No.: 09/033,827)	Customer Number: 22827
)	
Filed: March 3, 1998)	Deposit Account: 04-1403
)	
Title: Process For Separating)	Confirmation No.: 2557
Hazardous Metals From Waste)	
Materials During Vitrification)	

PETITION FOR RECONSIDERATION UNDER 37 CFR 1.378(e) TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a response/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is to be treated as the signature to the attachment in absence of a signature thereto.

Fee requirements (if any) have been calculated as shown below:

	Claims remaining after amendment		Highest number previously paid for		Present Extra		Amount		Additional Fee
Total Effective Claims		minus		=	0	x	\$ 62	=	\$ <u>0.00</u>
Independent Claims		minus		=	0	x	\$ 250	=	\$ <u>0.00</u>

- ☐ A Request for Continued Examination is requested in view of the: (\$930) \$ 0.00
- ☐ Previously submitted Amendment / Response dated _____
- ☐ Enclosed Amendment / Reply
- ☐ Enclosed Affidavit(s) / Declaration(s)
- ☐ Enclosed Information Disclosure Statement

Since Official Action set an original due date of _____,

PETITION is hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$150; 2 months \$570; 3 months \$1,290; 4 months \$2,010, 5 months \$2,730

\$ 0.00

If amendment enters proper multiple dependent claim(s) into this application for first time, add \$460.00 (per application)

\$ 0.00

If Terminal Disclaimer enclosed, add Rule 20(d) Official Fee (\$160.00)

\$ 0.00

Other: PETITION FEE

\$ 400.00

SUBTOTAL:

\$ 400.00

If "small entity" verified statement filed ☐ previously,

☐ herewith, enter one-half (1/2) of subtotal and subtract

- \$ 0.00

TOTAL FEE ENCLOSED:

\$ 400.00

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

DORITY & MANNING ATTORNEYS AT LAW, P.A.

ADDRESS:

Post Office Box 1449
Greenville, SC 29602 USA
Customer ID No.: 22827
Telephone: (864) 271-1592
Facsimile: (864) 233-7342

By: Timothy A. Cassidy Reg. No: 38,024

Signature: _____

Date: February 6, 2013

I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on February 6, 2013.

Pamela Knorr

(Typed or printed name of person transmitting documents)

Pamela Knorr

(Signature of person transmitting documents)

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PETITION FOR RECONSIDERATION UNDER 37 CFR 1.378(e)
TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF
MAINTENANCE FEE IN AN EXPIRED PATENT

AJT Enterprises respectfully requests reconsideration of the decision dated December 7, 2012 to dismiss the Petition Under 37 CFR 1.378(b), filed on May 21, 2012, to accept the unavoidably delayed payment of a maintenance fee for the above identified patent.

The petition filed on May 21, 2012 is incorporated herein by reference.

A petition to accept the delayed payment of a maintenance fee under 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). In the communication dated December 7, 2012, the Patent Office dismissed the previously filed petition asserting that Item 1 above was lacking. In the communication dated December 7, 2012, the Patent Office dismissed the previously filed petition requesting evidence about the docketing system maintained by Clemson University and whether the instant patent was entered into the docketing system. The communication also requested evidence that Clemson University would be responsible for tracking the maintenance fee due dates.

In response, enclosed is a Declaration executed by the undersigned. The Declaration states that Clemson University during the relevant time period relied on the undersign's law firm to track and pay maintenance fees and that the law firm's docketing system was sophisticated. The Declaration also makes clear that the instant patent was

entered into the docketing system and that Clemson University was made aware of the need to pay the 7.5 year maintenance fee.

As established in the previously filed Declaration of Gerald Addison (which is resubmitted herewith), Clemson University agreed to pay all maintenance fees with respect to U.S. Patent No. 6,136,063.

Filed herewith is a Second Declaration of Gerald Addison which quotes language from the Agreement between Clemson University and AJT Enterprises. According to the Agreement, if Clemson University decided not to contribute its share of costs for maintaining the patent after issuance, Clemson University was to notify AJT Enterprises and to grant AJT Enterprises sole ownership of the patent. Both Declarations of Gerald Addison make clear that Clemson University failed to pay the maintenance fee and also failed to notify AJT Enterprises of its intention not to pay the maintenance fee.

According to the Agreement between Clemson University and AJT Enterprises as quoted in the second Declaration of Gerald Addison, Clemson University could not abandon the '063 patent without notifying AJT Enterprises. Instead, Clemson University was under an obligation to notify AJT Enterprises if a maintenance fee was not to be paid and sole ownership of the patent would then automatically be granted to AJT Enterprises.

Since AJT Enterprises was not contacted, AJT Enterprises naturally assumed, as a reasonable and prudent person would, that the maintenance fee was in fact paid; especially in view of Clemson University's sophistication in intellectual property matters, in view of the highly sophisticated docketing system that Clemson University employed to pay maintenance fees, and in view of Clemson University's obligations under the Agreement.

Thus, the combined Declarations show:

1. AJT Enterprises knew of the need to make the maintenance fee payment;
2. AJT Enterprises and Clemson University agreed that Clemson University would track the relevant dates for payment of the maintenance fees by using a sophisticated docketing system and maintenance fee payment service. The subject patent was also entered into the docketing system.
3. AJT Enterprises treated the payment of the maintenance fee as his most important business. In order to ensure that the maintenance fees were docketed and timely paid, AJT Enterprises negotiated with Clemson University that Clemson University should monitor and pay all such maintenance fees because Clemson University is not only very knowledgeable in IP matters but also was using a sophisticated docketing system and maintenance fee payment service during the relevant time period. AJT Enterprises, on the other hand, did not have at its disposal a sophisticated docketing system for tracking maintenance fees. Thus, under the circumstances, AJT Enterprises exercised due care of a reasonably prudent person in having Clemson University agree to track and pay all maintenance fees.

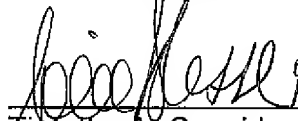
4. AJT Enterprises was prevented from making the payment of the maintenance fee because Clemson University never informed AJT Enterprises that the maintenance fee was not being paid. Due to Clemson University's expertise in intellectual property matters, it was completely reasonable and prudent to conclude that the maintenance fee was in fact paid when AJT Enterprises was not contacted regarding the 7.5 year maintenance fee. There is no question that it was completely reasonable to rely on Clemson University to pay the outstanding maintenance fee and, if not paid, to contact AJT Enterprises as agreed to in writing between the parties.

5. The Declaration of Gerald Addison also makes clear that AJT Enterprises was diligent in preparing and filing the original petition to accept the delayed payment of the maintenance fee.

In view of the above, AJT Enterprises requests that the petition should be granted and the patent should be revived.

Respectfully submitted,

DORITY & MANNING, P.A.



Timothy A. Cassidy
Reg. No. 38,024

2/6/13
Date

P.O. Box 1449
Greenville, SC 29602
(864) 271-1592
(864) 233-7342

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No: 6,136,063)
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Issue Date: October 24, 2000)
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Application Serial No.: 09/033,827)
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Filed: March 3, 1998)
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Title: Process For Separating Hazardous)
Metals From Waste Materials During)
Vitrification)

Commissioner of Patents
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DECLARATION

I, Timothy A. Cassidy, declare as follows:


1. I am an attorney with the law firm of Dority & Manning located in Greenville, South Carolina. I am licensed to practice before the United States Patent and Trademark Office with registration number 38,024.

2. During the time period of from October 24, 2007 to October 24, 2008, our firm monitored U.S. maintenance fee payments for Clemson University. During the above time period, it is my opinion that our firm's docketing system was very sophisticated. In particular, our firm was using a docketing system and a maintenance fee payment service offered by Thomson Reuters, a third party.

3. U.S. Patent No. 6,136,063 was entered into the docketing system described above. Clemson University was made aware that the 7.5 year maintenance fee for the '063 patent was due. Our firm did not receive instructions to pay the maintenance fee from Clemson University.

Respectfully submitted,

Feb 6, 2013
Date


Timothy A. Cassidy

PATENT

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DECLARATION OF GERALD ADDISON

I, Gerald Addison, declare as follows:

1. I am Chief Operating Officer of AJT Enterprises, Inc. located in St. Stephen, South Carolina.
2. AJT Enterprises was the co-owner of U.S. Patent No. 6,136,063, which issued on October 24, 2000 and is entitled "Process for Separating Hazardous Metals From Waste Materials During Vitrification". The other co-owner was Clemson University.
3. Clemson University and AJT Enterprises, Inc. entered into a business agreement on November 12, 1997.
4. The following is language quoted from the Agreement between Clemson University and AJT Enterprises, Inc.:

If either party declines to contribute its share of costs for maintaining the patents after their issuance or for filing foreign patent applications, thereby indicating its desire to allow said patent to become abandoned or not to pursue patent protection in a foreign country, the other party may elect to pay the fees or take such steps as are necessary to maintain such patent in full force and effect or to file such

patent application. In such cases, the party paying such fees or taking such steps shall be granted sole ownership to said patent by an appropriate assignment by the other party and said other party shall not be entitled to receive further royalties that can be attributed to such patent.

As shown above, according to the Agreement, if Clemson University decided not to contribute its share of costs for maintaining the patent after issuance, Clemson University was to notify AJT Enterprises and to grant AJT Enterprises sole ownership of the patent.

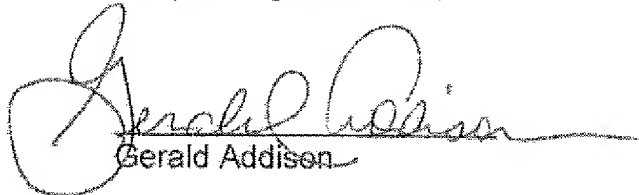
5. Clemson University agreed to docket and track payment of the maintenance fees and to pay the maintenance fees when due. Clemson University, according to the Agreement as quoted above, was obligated to notify AJT Enterprises if a maintenance fee was not paid.

6. When the Agreement with Clemson University was negotiated, Clemson University was more sophisticated in intellectual property matters than AJT Enterprises. Clemson University had access to a sophisticated docketing system and maintenance fee payment service. AJT Enterprises, on the other hand, did not have access to any sophisticated docketing system for tracking maintenance fee dates. Consequently, we felt it was completely reasonable to rely on Clemson University to track and pay maintenance fees. In fact, having Clemson University track and pay maintenance fees was much more prudent and careful than if AJT Enterprises was left with the responsibility.

7. Clemson University failed to pay the maintenance fee and failed to notify AJT Enterprises that the maintenance fee was not paid.

Respectfully submitted,

5 FEB. 2013
Date


Gerald Addison

PATENT

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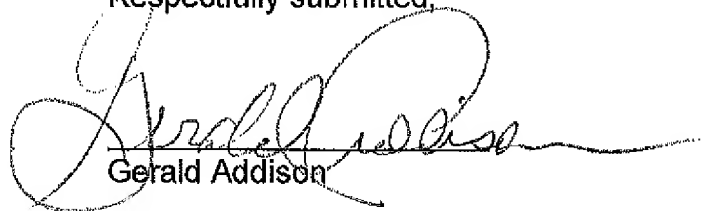
1. I am Chief Operating Officer of AJT Enterprises, Inc. located in St. Stephen, South Carolina.
2. AJT Enterprises was the co-owner of U.S. Patent No. 6,136,063, which issued on October 24, 2000 and is entitled "Process for Separating Hazardous Metals From Waste Materials During Vitrification". The other co-owner was Clemson University.
3. Clemson University and AJT Enterprises, Inc. entered into a business agreement on November 12, 1997.
4. Clemson University prosecutes and maintains a significant patent portfolio. Because of their expertise, Clemson agreed to pay all maintenance fees with respect to U.S. Patent No. 6,136,063. According to the Agreement, if Clemson University decided not to contribute its share of costs for maintaining the patent after issuance, Clemson University was to notify AJT Enterprises and to grant to AJT Enterprises sole ownership of the patent.

5. Recently, it has come to the attention of AJT Enterprises that Clemson University failed to pay the previous maintenance fee with respect to U.S. Patent No. 6,136,063. Clemson University also failed to notify AJT Enterprises of its intention not to pay the maintenance fee.

6. When AJT Enterprises became aware that the maintenance fee had not been paid for U.S. Patent No. 6,136,063, AJT Enterprises immediately contacted Clemson University to determine if Clemson University had in fact paid the maintenance fee. Clemson University formally responded in the last few weeks by indicating that the maintenance fee was not in fact paid and that they did not have any record of notifying AJT Enterprises of its intention not to pay the maintenance fee. Clemson University also signed an agreement on April 9, 2012 giving AJT Enterprises full and sole ownership of any residual rights in the patent.

Respectfully submitted,

11 May 2012
Date


Gerald Addison